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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/027,681  | 12/21/2001  | T. Daniel Gross      | 16497.43            | 2036             |
| 57360 7590 07/08/2009<br>WORKMAN NYDEGGER<br>1000 EAGLE GATE TOWER,<br>60 EAST SOUTH TEMPLE<br>SALT LAKE CITY, UT 84111 |             |                      |                     |                  |
| EXAMINER<br>YABUT, DIANE D  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3734  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 07/08/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/027,681

**Applicant(s)**

GROSS ET AL.

**Examiner**

DIANE YABUT

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7 and 27-35 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3-7 and 27-35 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 04/23/2009  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/23/2009 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/23/2009 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-7 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 5 and 31 recite the limitation "the sharpened edge" both in line 2. There is insufficient antecedent basis for this limitation in the claims. For examination purposes, the sharpened edge is referred to as the sharpened edge of the cutting member.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3-4, 27-30, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by **Asnis** (U.S. Patent No. **5,059,201**).

Asnis discloses a shaft **24** having a proximal end and a distal end and an axis therebetween, the shaft having a groove (lumen) formed in a side thereof, the groove extending from the distal end toward the proximal end and being in communication with an opening formed in the side (proximal tip) of the shaft, the opening disposed proximal the distal end of the shaft, a cutting member **102** (cutting surfaces **106** or **108** which face proximally, Figures 3-4) slidably disposed within the shaft, a suture retainer **202** slidably disposed within the shaft and within the cutting member, the suture retainer having a suture protector **206** in an exterior surface of the suture retainer, the suture protector extending from a retainer distal end toward a retainer proximal end, and a handle (any of portions **308**, **350**, or **352**) disposed adjacent the proximal end of the shaft including independently operable first **208** and second **304** levers each slidably received within the handle, the first lever operatively coupled to the suture retainer to move the suture retainer within the shaft and within the cutting member and the second lever operatively coupled to the cutting member to move the cutting member within the shaft and around the suture retainer to cut the suture and being transverse to the

handle, and extending through the handle (see Figures 1, 3-4, 6, and 10-12). A biasing member **338** is in communication with the second lever, and therefore the cutting member (Figure 8).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-7 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asnis** (U.S. Patent No. **5,059,201**) in view of **Buelna** (U.S. Patent No. **5,242,459**).

Asnis discloses the cutting member **102** being retracted within the shaft until withdrawn by an applying a force to the second lever **304**, and a suture **400** that is disposed within the groove and opening by retracting the suture retainer within the shaft by applying a force to the first lever (Figure 13-15), but does not expressly disclose the shaft having an opening with a proximal edge, the sharpened edge of the cutting member being adapted to engage the proximal edge to sever suture when suture is disposed through the groove and opening.

Buelna teach an opening **38** of a shaft having a proximal edge and a cutting member **30** having a sharpened edge **36** which is adapted to engage the proximal edge to sever suture when suture is disposed through the groove and opening (Figures 4-6). It would have been obvious to one of ordinary skill in the art at the time of invention to

provide an opening with a proximal edge that engages the sharpened edge of the cutting member to sever the suture, as taught by Buelna, to Asnis in order to facilitate manipulation of the suture and subsequent trimming of the suture simply by moving the cutting member in a single motion (see abstract).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 3-7 and 27-35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734